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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,626	10/11/2001	Robert E. Haines	10007582-1	1665

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

BLAIR, DOUGLAS B

ART UNIT	PAPER NUMBER
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2442

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12/02/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/976,626	Applicant(s) HAINES ET AL.	
	Examiner DOUGLAS B. BLAIR	Art Unit 2442	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-16 and 18-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-16 and 18-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Appeal Brief

In view of the Appeal Brief filed on 8/24/2009, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/saleh najjar/

Supervisory Patent Examiner, Art Unit 2455.

Response to Arguments

Applicant's arguments, see Appeal Brief page 11, filed 8/24/2009, with respect to the previous 35 USC section 101 rejection of claims 27-35 have been fully considered and are persuasive. The 35 USC section 101 rejection of claims 27-35 has been withdrawn.

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Applicant's arguments, see Appeal Brief pages 12-22, filed 8/24/2009, with respect to the prior art rejections have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the Shimamura reference, 35 USC section 112 1st paragraph, and 35 USC section 101.

The applicant's disclosure incorporates a document by reference that was not supplied by the applicant. This document is necessary for determining patentability of the claims.

37 CFR 1.105 Requirement For Information

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

In response to this requirement, please provide a copy of each of the following items of art referred to in the applicant's specification on page 5: **"PML Protocol Specification, Hewlett-Packard Company, 11/18/1998, Revision 2.3"**.

In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in applicant's disclosure.

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete

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communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained may be accepted as a complete reply to the requirement for that item.

This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-8, 10-16, 18-23, and 25-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant references a protocol called PML throughout the specification

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as providing the written description for the claimed configuring and configuration details
however there is not evidence that the PML protocol every existed.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 21-23, 25, and 26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims are directed towards an article of manufacture comprising a computer usable medium. The applicant's specification only discusses a communication medium in support of the term medium (See page 5). Page 6 of the applicant's specification describes how the claimed medium could be a carrier wave. Therefore the claimed article of manufacture is broad enough to cover only a carrier wave. A claim to a carrier wave does not fit into any of the statutory categories of invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

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subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6, 8, 10, 11, 14-16, 21-23, and 27-35 are rejected under 35 U.S.C. 102(a) and (e) as being anticipated by U.S. Patent Application Publication Number 2001/003827 by Shimamura.

Before addressing the specific rejections it is important to resolve the applicant's definitions of some of the terms used in the applicant's claims:

Undersigned website: this term first appeared in the claims in the response filed on 6/13/2005 by the applicant. There is not limiting definition provided of the term by the applicant. An email server reads on the applicant's claimed undersigned website.

Hardcopy output engine: the applicant does not supply a limiting definition of a hardcopy output engine but does state that examples are photo copiers, facsimile machines, printers and devices including one or more of these capabilities.

Embedded web server: "Embedded web server 26 refers to a web server that is completely contained within a device, such as a computer peripheral device. Embedded web servers 26 are configured to provide management information about the peripheral device. An embedded web server 26 can be used to manage or manipulate individual peripheral devices, such as the hard copy output engine 14, that are present in the network 10. (pages 6 and 7)" and "In one embodiment, the vendor web site may send an email directly to the embedded web server with the configuration data in the step S25. The embedded web server 26 then uses this electronic communication to set the thresholds in the peripheral device via the embedded web server in the step S26.(page 10 of the specification)". This definition is broad enough to encompass anything which receives email over a network.

As to claim 1, Shimamura teaches a method of configuring a hard copy output engine comprising: receiving an electronic message including hard copy output engine configuration data from an undesignated website (Fig. 1. ref. number 102) through a firewall (Fig. 1, ref. numbers 104 and 301), wherein the electronic message transmitted through the firewall designates a hardcopy output engine to be configured (Fig. 9); and configuring the hard copy output engine using the hard copy output engine configuration data (Figure 3, the command executer performs the configuration).

As to claim 2, Shimamura teaches the method of claim 1, wherein receiving the electronic message comprises receiving an email at the hard copy output engine and wherein configuring comprises configuring the hard copy output engine via an embedded web server (E-mail transmitter/receiver 401 in Figure 3) contained in the hard copy output engine using the hard copy output engine configuration data (Figure 3).

As to claim 3, Shimamura teaches the method of claim 1, wherein receiving the electronic message comprises receiving an email (Figures 1, 3-10).

As to claim 4, Shimamura teaches the method of claim 1, wherein receiving the electronic message comprises: receiving an email through the firewall at a first user station; and forwarding the email to the hard copy output engine (email server in Figure 1 forwards to device).

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As to claim 6, Shimamura teaches the method of claim 1, wherein the hard copy output engine is chosen from a group consisting of: facsimile machines, photocopiers and printers (paragraph 3).

As to claim 8, 10, 11, 14-16, 19, 21-23, and 27-35, they are rejected for the same reasoning as claims 1-4 and 6.

Claim Rejections - 35 USC § 103

Claims 5, 7, 12, 13, 18, 20, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication Number 2001/003827 by Shimamura.

As to claims 5, 7, 12, 13, 18, 20, 25, and 26, Shimamura does not explicitly teach the use of an XML script. Official notice is taken that an XML script was a well known way to configure a device. The applicant discloses no details about XML scripts so the applicant must have assumed one of ordinary skill would have been able to carry out the claimed invention, otherwise the applicant would not have met the enablement requirement. Official notice is also taken that the claimed elements and data of claim 5 and 7 are well known peripheral parameters. The applicant discloses nothing novel about their use. It would have been obvious to one of ordinary skill in the art to combine the teachings of Shimamura with the well known concepts described in this rejection because such teachings are ubiquitous in the peripheral art.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOUGLAS B. BLAIR whose telephone number is (571)272-3893. The examiner can normally be reached on 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Douglas B Blair/
Primary Examiner, Art Unit 2442
/saleh najjar/
Supervisory Patent Examiner, Art Unit 2455